Quarles & Brady Streich Lang LLP

Renaissance One
Two North Central Avenue
Phoenix, Arizona 85004-2391
602.229.5200
Fax 602.229.5690
www.quarles.com

Attorneys at Law in
Milwaukee and Madison, Wisconsin
Naples and Boca Raton, Florida
Phoenix and Tucson, Arizona
Chicago, Illinois

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From:	Robert D. Atkins	602.229.5690	602.229.5311
Re:	USSN: 10/613,281 Confirmation No. 4021 Applicant: Brookshire, M.		

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Application Number	10/613,281
Filing Date	July 3, 2003
First Named Inventor	Michael D. Brookshire
Art Unit	3677
Examiner Name	Lavinder, Jack W.
Attorney Docket Number	121238.00003

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
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- ☐ Amendment/Reply
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
- ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Robert D. Atkins, Reg. No. 34,288 - QUARLES & BRADY STREICH LANG LLP
Signature	Robert D. Atkins
Date	September 25, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant(s)	:	Michael D. Brookshire
Serial Number	:	10/613,281
Date of Filing	:	July 3, 2003
Title	:	*METHOD OF FACETING GEMSTONES TO PRODUCE SPIRALING EFFECT*
Confirmation No.	:	4021
Art Unit	:	3677
Examiner	:	Lavinder, Jack W.
USPTO Customer No.	:	26707
Attorney Docket No.	:	121236.00003

REPLY BRIEF

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Sir:

Appellant hereby submits this Reply Brief in response to the Examiner's Answer mailed July 25, 2006. Appellant wishes to maintain the present appeal.

II. STATUS OF CLAIMS

The present application contains 20 pending claims. Claims 25-44 have been finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 25-44 have further been finally

rejected under 35 U.S.C. §103(a) as being unpatentable over the Diagrams for Faceting reference in view of Meyer (250378), Schenck (D35938), and Schenck (43724). A copy of claims 25-44, the claims on Appeal, is provided in the Appeal Brief.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 25-44 are indefinite under U.S.C. § 112, second paragraph.

Whether claims 25-44 are unpatentable under U.S.C. § 103(a) over the Diagrams for Faceting reference in view of Meyer (250378), Schenck (D35938), and Schenck (43724).

III. ARGUMENT

Appellant's Appeal Brief filed April 24, 2006, addresses the rejection of claims 25-44 under 35 U.S.C. § 103(a) over the Diagrams for Faceting reference in view of Meyer (250378), Schenck (D35938), and Schenck (43724). Appellant believes the Examiner's Answer contains no new grounds for rejection based on 35 U.S.C. § 103(a). No further discussion concerning the 103 rejection is deemed to be necessary or appropriate. However, Appellant believes the Examiner has presented new grounds for rejection based on 35 U.S.C. 112, second paragraph. Accordingly, Appellant submits this Rely Brief to address the 112 rejection.

The Examiner rejects claims 25-44 based on the claim preamble which contains the language "naturally occurring precious gemstone." The Examiner believes that a precious gemstone cannot be naturally occurring.

Appellants respectfully traverse the rejection of claims 25-44 under 35 U.S.C. 112, second paragraph. Appellant believes

that the Examiner is taking an unreasonable interpretation of the language "naturally occurring precious gemstone." The words "naturally", "occurring", and "precious" are adjectives to the noun "gemstone." Each of these adjectives describes or modifies the noun to more clearly state the subject matter of the present invention. The words "naturally" and "occurring" are intended to be read together to indicate the origin of the gemstone, prior to modification by human hands, i.e. from natural sources. In the specification, the naturally occurring gemstone is supported by a diamond, see page 2, line 4. No one would be confused to say that a diamond is a "naturally occurring gemstone." In that context, it is understood that the "naturally occurring" modifies "gemstone" to indicate its origin. Diamond rough is formed in the earth over eons of time. The diamond rough has value in its original state and many potential uses, including lasers, cutting tools, and jewelry. It is generally understood in the industry that diamonds become precious when modified by human hands (cut) to take on visually appealing characteristics. By cutting the diamond in a particular manner, light reflects through its internal structure and produces a highly desirable brilliance or scintillation. The diamond rough becomes a precious gemstone suitable for jewelry.

The Examiner rejection under 35 U.S.C. 112, second paragraph, is considered to be improper and an unreasonable interpretation of the claim language. The Examiner admitted choose not to reject the claims under 35 U.S.C. 101 as claiming non-statutory subject matter, i.e. naturally occurring things. The Examiner expressly states that:

> "[f]rom viewing the body of the claims, it is clear that the appellant is not trying to claim something that has naturally occurred in nature. The body of the claims discusses all the different cut facets in the stone, which could never naturally occur in nature."

Appellant believe that the Examiner's logic fails when he states that "a precious gemstone cannot naturally occur." This interpretation takes an unreasonably narrow and inconsistent view of the claim language. While it is true that one does not extract cut diamonds from the ground, it does not follow that the precious gemstone cannot have a naturally occurring origin. When read with the main body of the claim, one of ordinary skill in the art would understand that the preamble refers to the gemstone has having a naturally occurring origin, which is then modified to be have a precious state. It is the modification of the naturally occurring precious gemstone that is the subject matter of the present invention as recited in the main body of the claims.

Appellant has tried to be very precise and definite in the recitation of the present invention. The combination of the words "naturally occurring precious gemstone" provides a highly descriptive and definite recitation of the present invention. The gemstone has a naturally occurring origin (as oppose to artificial) and the gemstone is precious, i.e. modified by human hands from its naturally occurring state to become highly desirable. Accordingly, claims 25-44 are considered definite within the intent of 35 U.S.C. 112, second paragraph, because one of ordinary skill in the art would understand the metes and bounds of the claimed subject matter.

V. CONCLUSION

As a consequence, Appellant requests reversal of the final rejection of claims 25-44 in the instant patent application.

Respectfully submitted,
QUARLES & BRADY STREICH LANG LLP

September 25, 2006

By: Robert D. Atkins
Robert D. Atkins
Registration No. 34,288

Address all correspondence to:
Robert D. Atkins
Quarles & Brady Streich Lang LLP
One Renaissance Square
Two North Central Avenue
Phoenix, AZ 85004
Telephone: 602-229-5311
Facsimile: 602-229-5690
Email: rda@quarles.com